



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

R.G.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/326.526	06/04/99	GARNER, PH.D.	H 119929-1015

DANIEL F PEREZ
GARDERE & WAYNE LLP
1601 ELM STREET
SUITE 710
DALLAS TX 75201-4761

MM92/0911

EXAMINER

PHAN, J


ART UNIT PAPER NUMBER

2872

DATE MAILED: 09/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/326,526	Applicant(s) Garner	
	Examiner James Phan	Group Art Unit 2872	

☒ Responsive to communication(s) filed on Jun 23, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-38 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2872

Election/Restriction

1. The elected species including claims 1-2, 4-8, 13-16, 18-21 and 26-34, (note that claim 3 does not read on the elected species and that a complete response to applicant's traversal will be provided in the next office action), is further restricted below.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, 4-8, 13-16, 18-21 and 26-27, drawn to an apparatus for catalyzing a reaction on a substrate, classified in class 430, subclass 311.
- II. Claims 28-34, drawn to a method of patterning on a substrate, classified in class 430, subclass 296.

The inventions are distinct, each from the other because:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as an optical scanning device.

Because these inventions are distinct for the reasons above given above and have acquired a separate status in the art as shown by their different classifications, and the fields of search are not coextensive, i.e. invention I requires at least a search in class 430/309, 430/311, 359/223, and 359/224 while invention II does not, and invention II requires at least a search in class 430/296

Application/Control Number: 09/326,526

Page 3

Art Unit: 2872

and 359/900 while invention I does not, restriction for examination purposes as indicated is proper.

3. Any inquiry concerning this communication should be directed to James Phan whose telephone number is (703) 308-4810. The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Phan, J.

September 7, 2000


James Phan
Primary Examiner